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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,846	03/12/2004	Thomas L. Rainey	3616.237USC3	8498
23552	7590	09/29/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			MAYO, TARA L	
			ART UNIT	PAPER NUMBER
			3671	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/799,846

Applicant(s)

RAINEY ET AL.

Examiner

Tara L. Mayo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12 March 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Applicant is advised to amend the first paragraph of the Specification to include all priority information including the updated status of the parent applications.

### *Claim Objections*

2. Claim 6 is objected to because of the following informalities: improper antecedent basis. In claim 6 on line 12, delete "the" and insert therefor --a--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 6, the claimed invention is indefinite because it is not clear whether or not the scope is intended to encompass the "soil reinforcement member" recited on lines 12 through 13. For the purposes of prosecution on the merits, the Examiner has not considered the soil reinforcement to be positively claimed.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Owen (U.S. Patent No. 1,130,324).

Owen '324, as seen in Figures 1 and 2, shows a segmental retaining wall system comprising:

with regard to claim 1,

a wall block (10) comprising:

an interior block face for forming an interior surface of a segmental retaining wall;

an exterior block face for forming an exterior surface of a segmental retaining wall;

first and second block sides that extend from the exterior block face to the interior block face;

a block top surface having a lock channel (11) formed therein, the lock channel being defined by a channel front wall, a channel rear wall, and a channel bottom

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surface, the lock channel extending transversely across the block top surface from the first block side to the second block side, wherein the channel front wall forms a first shoulder that extends towards the interior block face so as to overhang a portion of the channel front wall, wherein the channel rear wall forms a second shoulder that extends towards the exterior block face so as to overhang a portion of the channel rear wall, and wherein the shoulders run generally parallel to each other along the lock channel; and

a block bottom surface;

with regard to claim 6,

wherein the wall block further comprises a lock flange (12) on the bottom surface of the block, the lock flange being defined by a flange front surface extending from the block bottom surface, a flange rear surface extending from the block bottom surface, and a flange bottom surface extending between the flange front and rear surfaces, the lock flange extending transversely across the block bottom surface in substantially the same direction as the lock channel, the lock flange being sized, shaped, and positioned so that the flange will fit into the lock channel of a similarly configured wall block in the adjacent lower course when a wall is constructed, wherein the flange front surface includes a portion that extends towards the exterior block face so as to overhang a portion of the flange front surface and is sized and shaped so as to engage the first shoulder of the lock channel of the similarly configured block either directly or indirectly if a portion of a soil reinforcement member is interposed between the flange front surface and the first should, such that when the wall block is stacked atop the

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similarly configured block, the wall block is properly aligned thereon and the engagement between the lock flange and lock channel of the similarly configured block resists forward leaning or toppling of the wall block.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owen (U.S. Patent No. 1,130,324) in view of Scales (U.S. Patent No. 5,417,523).

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Owen '324 discloses all of the features of the claimed invention with the exception(s) of:

with regard to claim 5,

the wall block further comprising an interior opening that extends from the first block side to the second block side, whereby, when a plurality of similarly configured blocks are laid side-by-side in a course, the interior openings align to form an internal channel running along the course.

Scales '523, as seen in Figures 1 and 3, shows an earth retaining wall (10) comprising a plurality of courses (12) of stacked blocks (14), each wall block comprising an interior opening (36) that extends from the first block side to the second block side, whereby, when a plurality of similarly configured blocks are laid side-by-side in a course, the interior openings align to form an internal channel running along the course, wherein the interior openings are included (col. 3, lines 41 through 45).

With regard to claim 5, it would have been obvious to one of ordinary skill in the art of static structures at the time of invention to modify the blocks shown by Owen '324 such that they would each include interior openings as taught by Scales '523. The motivation would have been to reduce the material costs and the weight of the blocks without sacrificing the required strength of the blocks for compression and stress forces.

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10. Claims 8 through 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owen (U.S. Patent No. 1,130,324).

Owen '324 discloses all of the features of the claimed invention with the exception(s)

of:

with regard to claim 8,

the channel bottom surface being arcuate;

with regard to claim 9,

the second shoulder being rounded so as to form a substantially arcuate rear edge of the lock channel;

with regard to claim 10,

the exterior block face sloping inwardly from the bottom surface to the top surface of the wall block; and

with regard to claim 11,

the wall block being formed of concrete.

With regard to claim 8, it would have been an obvious design choice for one of ordinary skill in the art at the time of invention to make the channel bottom surface arcuate. The motivation would have been to effect a desired channel shape in the block.



With regard to claim 9, it would have been an obvious design choice for one of ordinary skill in the art at the time of invention to make the second shoulder rounded so as to form a substantially arcuate rear edge of the lock channel. The motivation would have been to effect a desired channel shape.

With regard to claim 10, it would have been obvious to one of ordinary skill in the art of static structures at the time of invention to modify the blocks shown by Owen '324 such that the exterior block face would slope inwardly from the bottom surface to the top surface of the wall block. The motivation would have been to subsequently effect a retaining wall having a desired exterior appearance.

With regard to claim 11, it is a well-known expedient in the art of static structures to form wall blocks of concrete.

### ***Double Patenting***

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 1, 2, 3, 4 and 6 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 1(again), 2, 3 and 13 of prior U.S. Patent No. 6,758,636 B2. This is a double patenting rejection.

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 6 and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9 and 10 of U.S. Patent No. 6,758,636 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims include all of the limitations recited in the claims of the instant application.

15. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,338,597. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim includes all of the limitations recited in the claim of the instant application.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L. Mayo whose telephone number is 703-305-3019. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TLM  
22 September 2004



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PRIMARY EXAMINER